

REMARKS

Claims 54-64 and 66-93 are pending in this application. Claims 54-57, 59, 63-64, 66-71, 74-75, 78-81 and 83-92 have been amended. Claims 1-53 and 65 have been cancelled without prejudice or disclaimer to the subject matter recited therein.

Claims 1-53 and 65 have been canceled without prejudice or disclaimer, and claims 54-57, 59, 63-64, 66-71, 74-75, 78-81 and 83-92 have been amended, for the sole reason of advancing prosecution. Applicants, by canceling or amending any claims herein, make no admission as to the validity of any rejection made by the Examiner against any of these claims. Applicants reserve the right to reassert any of the claims canceled herein or the original claim scope of any claim amended herein, in a continuing application.

Claims 54-57, 59, 63-64, 66-71, 74-75, 78-81, and 83-92 have been amended to be in a form consistent with US practice. Additionally, the terms "cooling" and "freezing" recited in, e.g., claims 54, 86 and 93 have been deleted and replaced with the phrase "freeze drying." Support for the amendments to claims 54-57, 59, 63-64, 66-71, 74-75, 78-81 and 83-92 can be found throughout the specification and claims as originally filed.

No new matter has been added.

In view of the remarks set forth below, further and favorable consideration is respectfully requested.

I. Restriction Requirement

In the outstanding Official Action, the Examiner has required restriction of claims 54-93 to a single invention under 35 USC §§ 121 and 372. Claims 54-93 were subjected to a restriction requirement as follows:

- Group I - Claims 54-72 and 86-92, drawn to methods for preserving a biological material;
- Group II - Claims 73-81 and 93, drawn to preserved biological materials; and
- Group III- Claims 82-85, drawn to a method of preparing a preparation solution.

A. Provisional Election

Applicants hereby provisionally elect claims 54-72 and 86-92 of Group I, with traverse. Applicants reserve the right to file a divisional application directed to the non-elected subject matter.

B. Traversal

Applicants respectfully traverse the Examiner's restriction requirement for the following reasons.

Applicants respectfully traverse this restriction/election requirement because each of the "Groups" of claims that the Examiner alleges are "unrelated" share a ***special technical feature*** within the meaning of PCT Rule 13.2. Accordingly, all of the presently pending claims possess unity of invention and restriction, therefore, is improper.

PCT Rule 13.2 states the following, in relevant part:

[T]he requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression 'special technical features' shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

In the present application, the special technical feature that is shared between Groups I-III is the biological material. Therefore, Applicants respectfully submit that the claims of Group I-III possess "unity of invention" because they share a special technical feature as required by PCT Rule 13.2.

In addition to being improper on the basis of unity of invention, the restriction requirement is further traversed because, for example, MPEP § 803 specifies that restriction/election between two groups of claims is only proper when (1) one group of claims is independent *or* distinct from another group of claims and (2) a "serious burden" exists on the examiner in examining both groups of claims.

The Examiner can show a "serious burden" by establishing one of: the inventions are classified separately; the inventions have been classified together, but it can be shown that each subject has formed a separate subject for inventive effort (can cite patents or show a separate field of search); or the inventions require a separate field of search, that is, it is necessary to search for one subject in a place where no pertinent art for the other subject exists (MPEP § 808.02 (c)).

In the present application, the restriction requirement is further traversed because it omits "an appropriate explanation" as to the existence of a "serious burden" if a restriction were not required between Groups I-III. See MPEP § 803. A complete and

thorough search for the invention set forth in all of the alleged Groups would require searching the art areas appropriate to the other Groups. Since a search of each of the subject matter recited in Groups I-III would be coextensive, it would not be a *serious* burden upon the Examiner to examine all of the claims in this application.

Furthermore, Applicants have paid a filing fee for an examination of all the claims in this application. If the Examiner refuses to examine the claims paid for when filing this application and persists in requiring applicants to file divisional applications for each of the groups of claims, the Examiner would essentially be forcing applicants to pay duplicative fees for the non-elected or withdrawn claims, inasmuch as the original filing fees for the claims (which would be later prosecuted in divisional applications) are not refundable.

Accordingly, Applicants respectfully submit that the restriction requirement is improper. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw the restriction of claims required by the outstanding Official Action.

II. Species Election

Upon election of Claims 54-72 and 86-92 of Group I, the Examiner has further required that Applicants elect a single species from the following listing for purposes of examination: red blood cells; white blood cells; mononuclear cells; umbilical cord blood cells; hematopoietic stem cells; and bacteria.

Applicants hereby provisionally hematopoietic stem cells as a species for examination, without traverse. Applicants note that at least claims 54-64, 66 and 86-92 read on the elected species.

Applicants note that upon allowance of a generic claim, Applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR § 1.141.


CONCLUSION

Having made the required election, examination on the merits is earnestly solicited. Should the Examiner deem that any further action by Applicants' undersigned representative is desirable and/or necessary, the Examiner is invited to telephone the undersigned at the number set forth below.

In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 14-0112.

Respectfully submitted,

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